

Supreme Court, U. S.

FILED

MAY 11 1977

MICHAEL RODAK, JR., CLERK

IN THE
Supreme Court of the United States
OCTOBER TERM, 1976

No. 76-1442

A. G. SPALDING & BROS., INC., and
QUESTOR CORPORATION,
Petitioners,

v.

PAUL SULLIVAN SPORTS, INC.,
Respondent.

**BRIEF FOR RESPONDENT IN OPPOSITION TO THE
PETITION OF CERTIORARI IN THE SUPREME COURT**

JOHN A. LAHIVE, JR.
HERBERT P. KENWAY
KENWAY & JENNEY
24 School Street
Boston, Massachusetts 02108

TABLE OF CITATIONS

Cases	Page
<i>Application of Chitayat</i> , 408 F.2d 475 (C.C.P.A. 1969)	4
<i>Application of Wilson</i> , 312 F.2d 449 (C.C.P.A. 1963)	4
<i>Graham v. John Deere Co.</i> , 383 U.S. 1 (1966)	6
<i>Leeds & Northrup Company v. Doble Engineering Co.</i> , 159 F.2d 644 (1st Cir. 1947)	2
<i>McGrath v. Draper Corp.</i> , 384 F.2d 672 (1st Cir. 1967)	3
<i>McKay Radio and Telegraph Co., Inc. v. Radio Corporation of America</i> , 306 U.S. 86 (1939)	3
<i>Progressive Engineering Inc. v. Machinecraft, Inc.</i> , 273 F.2d 593 (1st Cir. 1960)	2

Note.

In this brief references to the Petition are in the form (Pet. p. 7). References to the Appendix to the Petition are in the form (P. App., pp. 36-38).

IN THE
Supreme Court of the United States

OCTOBER TERM, 1976

No. 76-1442

A. G. SPALDING & BROS., INC., and
QUESTOR CORPORATION,
Petitioners,

v.

PAUL SULLIVAN SPORTS, INC.,
Respondent.

**BRIEF FOR RESPONDENT IN OPPOSITION TO THE
PETITION OF CERTIORARI IN THE SUPREME COURT**

ARGUMENT

1. INTRODUCTION

The Petitioner presents two questions in its petition for a writ of certiorari. The first question is whether the law of the First Circuit is in conflict with that of the Second and Seventh Circuits. The second question concerns the factual basis of the lower Courts' decisions. Both questions are completely counterfeit. There is no conflict in the state of applicable law here between the circuits and, in fact, this Court has long since ruled on the point. As to the factual basis of the decisions, the Petitioner distorts the findings of both of the lower Courts

and now seeks a retrial of the fact issues. Petitioner's Statement of the Case is shot through with inaccuracies and misrepresents the evidence and findings of the Courts below. The opinions of both the Court of Appeals (P. App., pp. 11-16) and the District Court (P. App., pp. 32-38) reflect a clear understanding of the patented invention and the pertinent surrounding events. We have not, therefore, repeated these aspects of the case here.

2. THERE IS NO CONFLICT BETWEEN THE CIRCUITS

The "conflict" question presented by the Petitioner involves the use of the same standard of comparison for determining infringement as for determining validity. (Pet. p. 2) The Petitioner asserts that in the Second and Seventh Circuits, the same standard is used but in the First Circuit, as exemplified by the present case, different standards are used. The Petitioner is correct in its view of the settled law of the Second and Seventh Circuits and is simply uninformed as to the state of the law in the First Circuit.

This Court long ago enunciated the applicable principle of law in *McKay Radio and Telegraph Co., Inc. v. Radio Corporation of America*, 306 U.S. 86 (1939), and the First Circuit has consistently adhered to that principle, having declared itself thirty years ago in unmistakable terms:

"In other words, although it is conceded that the claim must be construed one way to decide the question of validity, it is suggested that we construe it another way to decide the question of infringement. It seems to us obvious that the claim must be construed the same way on both issues." *Leeds & Northrup Company v. Doble Engineering Co.*, 159 F.2d 644 (1st Cir. 1947).

There has been no departure from that position, the First Circuit having reiterated the principle, more re-

cently, in *Progressive Engineering Inc. v. Machinecraft, Inc.*, 273 F.2d 593 (1st Cir. 1960) and *McGrath v. Draper Corp.*, 384 F.2d 672 (1st Cir. 1967).

Accordingly, there is no conflict issue requiring resolution by this Court.

3. THE "FACTUAL ISSUE" ALLEGED BY PETITIONER IS GROUNDED ON MISREPRESENTATIONS

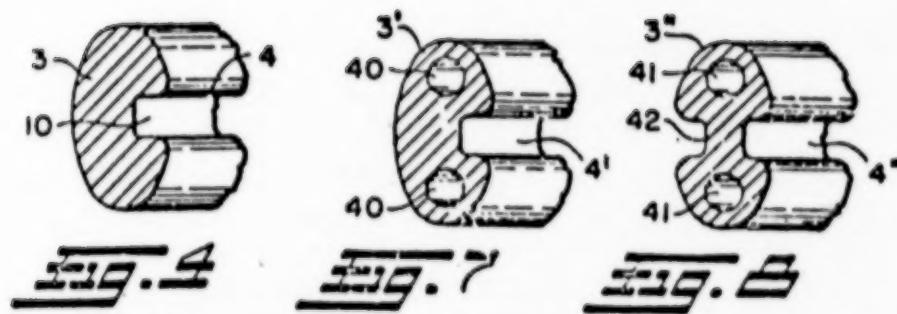
The Petitioner's second, or "factual issue" question concerns the validity of the patent, which the Petitioner asserts is predicated upon the "thickness of the walls of the extrusion" which forms a tubular frame for a tennis racket. The Petitioner goes further and asserts that in judging infringement such a change was considered by the Courts and the experts to be but "straight-forward engineering".

The Petitioner's thesis is based upon two misrepresentations, one relating to a distorted drawing of a prior art structure and the other harking back to the standard of comparison previously mentioned, but misquoting the Courts below.

A. The Petitioner Misrepresents The Prior Art

At page 7 of the Petition there appears a drawing complete with dimensions and annotations concerning wall thicknesses. It is identified as "Palmer Fig. 7." In truth, it bears little resemblance to Fig. 7 or any other pertinent figure of Palmer Patent No. 3,540,278 * as may quickly be established by glancing at the real reproduction of Figs. 4, 7 and 8 and the entire text of Palmer relating to those figures.

* It is interesting that Petitioners relied on Palmer as the primary reference in the District Court, switched to Robinson in the Circuit Court, and have once again switched back to Palmer (P. App., pp. 17, 22).



"A championship tennis racket can readily be obtained by making the frame 2 of extruded aluminum having the same cross-sectional configuration shown in Fig. 4, whereas a medium weight racket and a lady's racket may be obtained by using the extruded shapes of Figs. 7 or 8 with holes therein and perhaps the additional groove 42 which also impart greater flexibility to the frame." (P. App., p. 74)

Two things now become evident. The Petitioner created its own "Fig. 7" to suit its own purpose. It is a "cross-section" of a structure formed only in the Petitioner's imagination. More significantly, nowhere in the drawing or the text is there the slightest reference to any dimension. Yet, Petitioner has blithely added dimensions of accuracy running to three decimal places. The insertion of dimensions is even more surprising after rulings by both of the lower Courts that as a matter of law the drawings of a patent cannot be scaled up and dimensioned, P. App., pp. 19, 20 and pp. 43-44, citing *Application of Wilson*, 312 F.2d 449 (C.C.P.A. 1963) and *Application of Chitayat*, 408 F.2d 475 (C.C.P.A. 1969).

B. The Petitioner Misquotes The Courts Below To Show They Followed a "Double Standard"

The Petitioner would have it that the Courts below found infringement of the patent by concluding that certain differences between Spaldings' racket and the patent were "straightforward engineering", while these same differences were held to have "patentable significance"

when judging validity. This assertion appears first at page 2, is repeated at page 3, and is elaborated at page 5 of the petition. The Courts below engaged in no such sophistry. Actually, the only issue on infringement faced by either Court was unrelated to any finding on Palmer. Rather, it involved a consideration of *two* of the Petitioner's infringing rackets and whether or not a change from one to another avoided infringement. The claim in question called for a tubular frame member having a cross-section in which there is an interconnecting web of material more than twice as thick as the wall of each tube. All else in the claim had previously been admitted by the Petitioner to be met by its so-called "9A" racket. The Court of Appeals specifically noted that the District Court considered these facts in finding infringement:

"The district court relied on testimony from both sides that the change from *bi-hollow* to *tri-hollow* was 'straightforward engineering' and that the playability of the tri-hollow racket was indistinguishable from that of the bi-hollow." (Emphasis supplied) (P. App., p. 24)

Thus, the Petitioner's statements at pages 5 and 6 that the Court's infringement findings involved "enlarging the hollows" and "thick" and "thin" tube walls are entirely fictional. The same fiction is twice-repeated at page 9.

Having so misstated the Court's holding on infringement, the Petitioner at pages 8 and 9 baldly asserts that validity of the patent in suit over Palmer was predicated by the Courts below on similar "differences" of wall thickness and mid-section dimensions. This totally ignores the Court's real findings on what differentiated Palmer from the patent in suit.

Neither of the lower courts spoke of the differences between Palmer and the patent in suit being "straightforward engineering". On the contrary, the Trial Court directly addressed the very argument Petitioner now

makes, ruling that a change from Palmer to the patent in suit:

"involves changing a racket of unknown dimension or potential, formed by an elliptical bar with holes, into a sophisticated bi-hollow structure with its conforming walls having demonstrated capability." (P. App., p. 15)

This finding of validity of the patent in suit over Palmer * was made without reference to whether the center web was solid or hollow. Moreover, the finding of validity was reached by the District Court through a meticulous investigation of the primary and secondary factors ** set forth in *Graham v. John Deere*, 383 U.S. 1 (1966). In particular, the differences between Palmer and the patent in suit were the focus of a substantial portion of the almost 4000 pages of testimony and exhibits below, including that of Plaintiff's expert, Dr. Loutrel, a professor of Mechanical Engineering at M.I.T., and Defendant's experts, led by Dr. Kern, a professional engineer.

The trial court accepted the testimony of Dr. Loutrel that there is a "fundamental difference" between the Palmer structure and the patent in suit. (P. App., p. 47). The Court held that Palmer is not a tubular structure and does not have internal hollows having a shape conforming to the exterior shape of the tubes as required by the claims (P. App., p. 15) of the patent in suit. (Ct. of Appeals Opinion, P. App., pp. 21, 22; District Court Opinion, P. App., pp. 40, 41, 42).

* The Patent Office also found the patent in suit valid over Palmer as the principal reference.

** The Court also noted the complex nature of tennis racket designs and Spalding's own failure to develop a metal racket despite more than 30 years of effort by a staff of at least ten people to do so. What petitioner now characterizes as a "fad" is a product it has sold continuously from 1968 right until the present moment. (P. App., p. 49)

The Court of Appeals also addressed itself to the very argument now presented by Petitioner and rejected it (P. App., 21 and 22), specifically noting that, as here, Petitioner "misspoke itself" by stating that the District Court had ruled that the change from Palmer to the patent in suit was straightforward engineering. (P. App., 21 fn. 9) What the trial court did find was the slight modification made by Spalding—placing a lightening hole in the center web—was straightforward engineering and did not escape infringement. The opinions below make it very clear that this straightforward structural change, placing a hole in the center of the web, does *not* characterize the differences between Palmer and the patent in suit. Petitioner failed to mislead the Court of Appeals. We are confident that this Court will also see through this misrepresentation.

4. CONCLUSION

The Petitioner has seriously distorted facts and misrepresented the opinions of the lower Courts to create a counterfeit conflict which bears no relation to the record. Absent such a conflict, and in view of the Court of Appeals designation of its decision as "Not for Publication", this case does not merit the attention of this Court.

The Petition should be denied.

Respectfully submitted,

JOHN A. LAHIVE, JR.
HERBERT P. KENWAY
KENWAY & JENNEY
24 School Street
Boston, Massachusetts 02108